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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,200	12/27/2001	Robert E. Novak	4000.2.48	7751

32641 7590 12/21/2004

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EXAMINER	
LUU, SY D	

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,200	NOVAK ET AL.	
	Examiner	Art Unit	
	Sy D Luu	2174	

-- The MAILING DATE of this communicati n appears on the cover sheet with th c rrespondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/15/03 and prior*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/15/03, 8/5/02 & 7/29/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15, 17-39 and 41-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 15-33, 35-41 of copending Application No. 10/010736. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent

and the application are claiming common subject matter which is directed to a method/system for distributing personalized editions of media programs using bookmarks.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15, 17-29, and 31-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Sull et al ("Sull", US 2002/0069218 A1).

As per claims 1, 5-7 and 22, Sull teaches a method for distributing personalized editions of media programs (abstract; paragraph 365), the method comprising:

accessing a media program at an editing device (fig. 2);

receiving a designation of at least one excerpt of the media program for inclusion in a personalized edition of the media program, wherein the excerpt comprises a segment of interest within the media program, and generating at least one bookmark defining each designated excerpt of the media program (paragraphs 50, 54, and 70); and

transmitting, via internet or using a wireless technique, the at least one bookmark to a playback device having access to the media program, wherein the at least one bookmark is

usable by the playback device to present the personalized edition of the media program including only the at least one designated excerpt (paragraphs 52, 63, 71, 78).

As per claim 2, Sull teaches accessing the media program at the playback device from a source other than the editing device, receiving the at least one bookmark at the playback device, and presenting the personalized edition of the media program on the playback device including only the at least one designated excerpt (paragraph 51 et seq.).

As per claims 3-4, Sull teaches skipping at least one non-designated excerpt by starting presentation of the media program at a point defined by a next bookmark (paragraph 71; *inherently those frames of the media program that are outside of the designated excerpts would automatically be skipped from presenting*).

As per claims 8-10, Sull does not explicitly disclose the step of physically transporting the at least one bookmark from the editing device to the playback device on a removable storage medium, wherein the storage medium is selected from a group consisting of a magnetic disk, an optical disc, and a non-volatile flash memory card, and wherein the at least one bookmark is encapsulated within a program interface object (PIO). However, the use of removable storages as well as PIO are well known in the art. It would have been obvious to an artisan at the time of the invention to combine/include these features with Sull's teaching in order to provide additional flexible and convenient means/methods for transporting and handling/processing bookmarks.

As per claim 11, Sull teaches the at least one excerpt to comprise a plurality of excerpts, and the steps of receiving a designation of a presentation order for the plurality of excerpts, and transmitting an indicator of the sequential order to the playback device, wherein the indicator is

useable by the playback device to present the plurality of excerpts in the designated presentation order (paragraph 71).

As per claims 12-13, Sull teaches wherein at least one bookmark comprises a time reference, or a non-time positional reference (paragraph 54).

As per claims 14-15, Sull teaches wherein at least one bookmark marks a beginning point of an excerpt within the media program, and wherein at least one bookmark marks an end point of an excerpt within the media program (paragraphs 175 et seq., 330, and claim 16).

As per claim 17, Sull teaches wherein at least one bookmark comprises a directive to skip to a particular point within the media program (*inherent step that occurs in the case where the beginning point of the bookmark indicates a position which is an offset from the position of the current playing position*).

As per claims 18-21 and 23-24, Sull teaches: downloading the media program from a server (paragraph 55); digitally recording the media program from a broadcast medium, and the playback/editing device to comprise an ITV system (paragraphs 161, 328 and 521); and accessing a DVD storage medium including the media program (paragraph 70).

Claims 25-29, and 31-48 are similar in scope to claims 1-5, 7-23 and 1 respectively, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sull et al ("Sull", US 2002/0069218 A1) in view of Jakel et al. ("Jakel", US 2003/0016951 A1).

As per claim 16, Sull does not explicitly describes the at least one bookmark to mark both a beginning point and an end point of an excerpt within the media program. However, such a method is well known in the art. For instance, Jakel teaches an interval bookmark which defines both a beginning and ending of an interval of a media program (abstract). It would have been obvious to an artisan at the time of the invention to combine Jakel's teaching with Sull's method in order to enhance the bookmarking method by making a bookmark very compact.

Claim 30 is similar in scope to claim 6, and is therefore rejected under similar rationale.

Inquires

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(571) 272-4064**. The

examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

SY D. LUU
PRIMARY EXAMINER